

(f) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

§ 1.174 [Reserved]

60. Section 1.174 is removed and reserved.

61. Section 1.176 is revised to read as follows:

§ 1.176 Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

62. Section 1.177 is revised to read as follows:

§ 1.177 Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § 1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended,

unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

63. Section 1.178 is revised to read as follows:

§ 1.178 Original patent; continuing duty of applicant.

(a) The application for a reissue should be accompanied by either an offer to surrender the original patent, or the original patent itself, or if the original is lost or inaccessible, by a statement to that effect. The application may be accepted for examination in the absence of the original patent or the statement, but one or the other must be supplied before the application is allowed. If a reissue application is refused, the original patent, if surrendered, will be returned to applicant upon request.

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

64. Section 1.181 is amended by revising paragraph (f) to read as follows:

§ 1.181 Petition to the Commissioner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as

untimely, except as otherwise provided. This two-month period is not extendable.

65. Section 1.193 is amended by revising paragraph (b)(1) to read as follows:

§ 1.193 Examiner's answer and reply brief.

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

66. Section 1.303 is amended by revising paragraph (a) to read as follows:

§ 1.303 Civil action under 35 U.S.C. 145, 146, 306.

(a) Any applicant or any owner of a patent involved in a reexamination proceeding dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

67. Section 1.311 is amended by revising paragraph (b) to read as follows:

§ 1.311 Notice of allowance.

(b) An authorization to charge the issue fee (§ 1.18) to a deposit account may be filed in an individual application only after the mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee to any deposit account identified in a previously filed authorization to charge fees:

(1) An incorrect issue fee; or

Section 1.174: Section 1.174 is removed (and reserved) in view of the inclusion of all filing and amendment requirements for reissue drawings in amended § 1.173. Thus, in addition to the reissue filing requirements of former § 1.173, the reissue amendment requirements of former § 1.121(b) and the reissue drawing requirements of former § 1.174 are all included in a single rule, amended § 1.173. The changes consolidating several former rules into a single rule should make the requirements for all reissue filings and amendments quicker to locate and easier to understand.

Section 1.176: Section 1.176 is amended to create §§ 1.176(a) and (b). Section § 1.176(a) contains material retained from the former rule, while § 1.176(b) contains new material permitting certain restrictions.

Section 1.176 is amended to eliminate the prohibition against requiring division in a reissue application. The Federal Circuit has indicated that 35 U.S.C. 251 does not, under certain circumstances, prohibit an applicant in a reissue application from adding claims directed to an invention which is separate and distinct from the invention defined by the original patent claims. See *In re Amos*, 953 F.2d 613, 21 USPQ2d 1271 (Fed. Cir. 1991). Former § 1.176, however, prohibited the Office from making a restriction requirement in a reissue application. This prohibition in former § 1.176, in combination with the Federal Circuit's decision in *Amos*, frequently placed an unreasonable burden on the Office in requiring the examination of multiple inventions in a single reissue application.

Elimination of the prohibition against restriction in divisional application under § 1.176 is effective for reissue applications filed on or after the date that is sixty days after the date of publication in the *Federal Register*.

Section 1.176(b) now allows the Office to make a restriction requirement in a reissue application between claims added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between added claims and original patent claims is the same as that applied in an original application. See MPEP 806 through 806.05(i). Where a restriction requirement is made, the original patent claims will be held to be constructively elected and the examiner will issue an Office action on the merits

providing notification of the restriction requirement in such Office action.

If a requirement for restriction between the claims of the original patent and those added claims which are directed towards previously unclaimed subject matter is made by the examiner, the group containing the original patent claims (amended or unamended) will be held to be constructively elected, unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

The original patent claims (which have been constructively elected) will receive a complete examination on their merits, while the nonelected (added) claims (to any added invention(s)) will be held in abeyance in a withdrawn status. These nonelected (added) claims will only be examined if filed in a divisional reissue application. If the reissue application contains only original unamended claims and is found to be allowable, further action in the reissue application may have to be suspended, since the Office will not allow a reissue patent which does not correct any error in the original patent. If the divisional reissue application containing the added claims is examined and is found to be allowable, the Office may recombine the several sets of examined and allowable claims into one of the reissue applications, which then can be allowed. See the discussion of § 1.177 for additional details for presenting multiple reissue applications.

The Office is requiring a constructive election of the original (patented) claims to ensure that the original (patented) claims receive an examination on their merits. If a reissue applicant was permitted to elect the added claims directed toward previously unclaimed subject matter, and, after an examination of only these added claims, the divisional claims were determined to be unpatentable, applicant would most likely let the reissue application go abandoned and not file a divisional reissue application directed toward the original claims of the patent. In this circumstance, no examination of the original claims of the patent would be made. This would not be appropriate as the filing of the reissue application would mandate that the original patent claims be reevaluated/examined again. Thus, a constructive election of the original patent claims and an examination thereof in the first reissue application would force the applicant to file a divisional reissue application with claims to the added invention in order

to secure an examination of such added claims.

The Office will continue to not require restriction among original claims of the patent (*i.e.*, among claims that were in the patent prior to filing the reissue application) and the rule has been amended to reflect that practice. In order for restriction to be required between the original patent claims and added claims, the added claims must be directed toward inventions which are separate and distinct from the invention(s) defined by the original patent claims. Restriction between multiple inventions in the added claims will be permitted provided the added claims are drawn to several separate and distinct inventions.

Section 1.176 has been further amended to delete the two-month portion of the rule relating to when a reissue application will be acted upon. When any particular reissue application is taken up for action is an internal Office policy that need not be set forth in the rules of practice. Moreover, it is the intent of the Office to consider acting on divisional reissue applications prior to expiration of the two-month period after announcement of the reissue filing in the *Official Gazette*.

The amendments to this section are not intended to affect the types of errors that are or are not appropriate for correction under 35 U.S.C. 251 (*e.g.*, applicant's failure to timely file a divisional application is not considered to be the type of error that can be corrected by a reissue). See *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978); and *In re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977).

Section 1.177: The title to § 1.177 has been amended to read "Issuance of multiple reissue patents" in order to include procedures pertaining to continuation reissue applications as well as divisional reissue applications.

Section 1.177 is amended to eliminate former requirements that divisional reissues be limited to separate and distinct parts of the thing patented, and that they be issued simultaneously unless ordered by the Commissioner. The rule is expanded to include continuations of reissues as well as divisionals. See *In re Graff*, 111 F.3d 874, 876-77, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997). The Federal Circuit specifically stated:

... [35 U.S.C. 251, ¶ 3.] provides that the general rules for patent applications apply also to reissue applications, and [35 U.S.C. 251, ¶ 2.] expressly recognizes that there may be more than one reissue patent for distinct and separate parts of the thing patented. [35

U.S.C. 251] does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met. See [35 U.S.C. 251, ¶ 3]

[35 U.S.C. 251, ¶ 2.] is plainly intended as enabling, not limiting. [35 U.S.C. 251, ¶ 2.] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications, by codifying [*The Corn-Planter Patent*, 90 U.S. 181 (1874).] which recognized that more than one patent can result from a reissue proceeding. Thus, [35 U.S.C. 251, ¶ 2.] places no greater burden on [a] continuation reissue application than upon a continuation of an original application; [35 U.S.C. 251, ¶ 2.] neither overrides, enlarges, nor limits the statement in [35 U.S.C. 251, ¶ 3.] that the provisions of Title 35 apply to reissues.

See *id.* at 876-77, 42 USPQ2d at 1473.

Thus, the Federal Circuit has indicated that a continuation or divisional reissue application is not subject to any greater burden other than the burden imposed by 35 U.S.C. 120 and 121 on a continuation or divisional non-reissue application, except that a continuation or divisional reissue application must also comply with the statutory requirements specific to reissue applications (e.g., the "error without any deceptive intention" requirement of 35 U.S.C. 251, ¶ 1).

Following *Graff*, the Office has adopted a policy of treating continuations/divisionals of reissue applications in much the same manner as continuations/divisionals of non-reissue applications. Accordingly, the former requirements of § 1.177 as to petitioning for non-simultaneous issuance of multiple reissue patents, suspending prosecution in an allowable reissue application while the other is prosecuted, and limiting the content of each reissue application to separate and distinct parts of the thing patented, are all eliminated. These requirements were considered unique to reissue continuations/divisionals, imposed additional burdens on reissue applicants, and are now inconsistent with the Federal Circuit's discussion of 35 U.S.C. 251, ¶ 2, in *Graff*.

The changes to § 1.177 relating to divisional reissues are effective on the date of publication of the rule in the **Federal Register** for all pending and new reissue applications.

Additionally, § 1.177(a) is amended to require that all multiple reissue applications of a single patent include as the first line of the respective specifications a cross-reference to the other reissue application(s). The cross-

reference will provide the public with notice that more than one reissue application has been filed to correct an error (or errors) in a single patent. If one reissue has already issued without the appropriate cross-reference, a certificate of correction will be issued to provide the cross-reference in the issued reissue patent. The Office will initiate a certificate of correction under § 1.322 to include the appropriate cross-reference in the already issued first reissue patent before passing the pending reissue application to issue.

Section 1.177(b) is amended to require that all of the claims of the patent be presented in each application as amended, unamended or canceled, and that the same claim not be presented for examination in more than one application in its original unamended version. Any added claims must be numbered beginning with the next highest number following the last patent claim.

If the same or similar claims are presented in more than one of the multiple reissue applications, statutory double patenting (35 U.S.C. 101) or non-statutory (judicially created doctrine) double patenting may be considered by the examiner during examination, and appropriate rejections will be made. If needed to overcome the rejections, terminal disclaimers will be required in order to ensure common ownership of any non-distinct claims throughout each of the patents' lifetimes.

Amendments are concurrently made to permit restriction in reissue applications between the original patent claims and any added claims to separate and distinct subject matter (see change to § 1.176). If one or more divisional applications are filed after such a restriction requirement, § 1.177(c) provides that the resulting multiple reissue applications will be issued alone or together, but each of the reissue applications will be required to include changes which correct an error in the original patent before it can be issued as a reissue patent. If one of the applications resulting from the restriction requirement is found to be allowable without any changes relative to the patent (i.e., it includes only all the original patent claims), further action will be suspended until one other reissue application becomes allowable; then, the two will be recombined and issued as a single reissue patent. If the several reissue applications resulting from the restriction each include changes correcting some error in the original patent, the reissue applications could be issued separately, with an appropriate cross-reference to the

other(s) in each of the respective specifications.

Section 1.178: The title of § 1.178 is amended to reflect the addition of the material in new § 1.178(b), and the rule is amended to create § 1.178(a) containing some of the material in the former rule, and § 1.178(b).

Section 1.178(a) is amended to no longer require an offer to surrender the original patent at the time of filing as part of the reissue application filing requirements. Omission of this formality by applicants in the past has resulted in processing delays due to the Office's sending of a Notice to File Missing Parts of Application. The change to this section relaxes the former requirement and permits examination to commence without the "offer" to surrender the original patent. The requirement for actual surrender of the original patent (or a "statement" of its loss, as set out below) before the reissue application is allowed, however, is retained.

Section 1.178(a) is also amended to change "affidavit or declaration" (attesting to the loss or inaccessibility of the original patent) to "statement." This change will eliminate the verification requirements of the former rule, which are formalities covered by §§ 1.4 and 10.18.

Replacement in § 1.178(a) of the oath or declaration with a statement that the original patent is lost or inaccessible is effective on the date of publication in the **Federal Register** for all pending or new reissue applications.

Section 1.178(b) has been added to require reissue applicants to call to the attention of the Office any prior or concurrent proceeding in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigation (litigation covers any papers filed in the court or issued by the court, such as, for example, motions, pleadings, and court decisions including court orders) and the results of such proceedings. The duty to submit such information is a continuing duty and runs from the time the reissue application is filed until the reissue application is abandoned or issues as a reissue patent. The addition of § 1.178(b) is intended to further the Office's desire to make consistent both reissue and reexamination proceedings as much as possible (see §§ 1.565(a) and (b)). See also § 1.173(a)(1).

The need to call the attention of the Office to prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved applies to pending and new reissue applications.

Section 1.181: Section 1.181 provides generically for petitions to the